

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl No.: **10/528321**
Appellant: **Stephen Guffanti**
Filing Date: **September 26, 2005**
Art Unit/Conf. No: **3715/6770**
Examiner: **Bruk A. Gebremichael**
Attorney Docket No.: **100842.0002US**

Title **Initial Teaching Alphabet for Teaching Phonetics**

MS Appeal Brief - Patents
Commissioner of Patents and Trademarks
Washington, D.C. 20231
Attention: Board of Patent Appeals and Interferences

APPELLANT'S REPLY BRIEF UNDER 37 CFR § 41.37

This reply brief is filed in response to the Examiner's Answer filed October 28, 2010. The Applicant respectfully requests that the appeal filed on July 1, 2010 be maintained under 37 CFR §41.41, and also respectfully requests a **telephonic oral hearing** under 37 CFR §41.47.

ARGUMENT

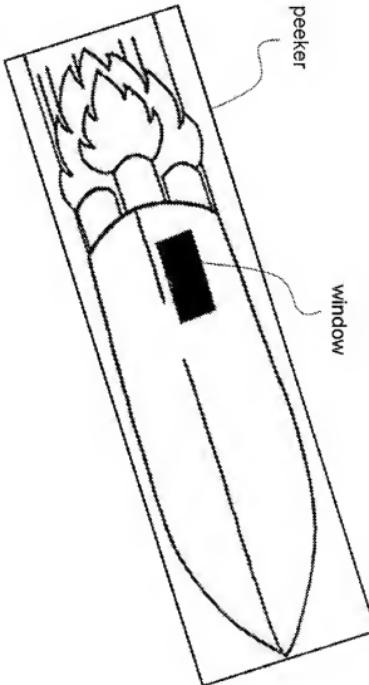
I. Objection to the Drawings

The Office reiterated its objection to the drawings under 37 CFR 1.83(a) as failing to show every feature of the invention specified in the claims. The Office argues that Figure 10 by itself fails to sufficiently illustrate the structure of Claim 14, which recites the claimed feature of a reading assist card having a window.

Applicant is unsure why the Office is making this objection since the Applicant did not appeal Claim 14. Nevertheless, Applicant argues that the claimed feature is sufficiently illustrated by Figures 10 and 11 in conjunction with the last full paragraph on page 7 of the specification, which states, "The 'peeker' referenced at the end of the page of Figure 10 is a card

having a window through which a child views a word and its associated adjacently position[ed] symbols. Selecting an appropriate size for the window relative to the text being read assists in blocking out other words, which in turn assists in focusing the child on the word being read. A sample peeker is shown in Figure 11. The particular peeker has a line drawing of a rocket, and a window measuring approximately 4 cm by 1.7 cm." Below is a copy of Figure 11, with identifiers that clearly identify the elements in the drawing.

Figure 11



II. Rejection of Claims 1-20 under 35 U.S.C. §101

The Office reiterated its objection to Claims 1-20 under 35 U.S.C. §101 as being directed to a non-statutory subject matter. Again, the Applicant is unsure why the Office reiterated its

objection to Claims 1-20 when the Applicant has only appealed Claims 15-20. Accordingly, the following arguments are targeted towards Claims 15-20 only.

Regarding Claims 15-20, the Office argues that the Claims are directed to a mere abstract idea as neither (1) being tied to a particular machine or apparatus, nor (2) transforming a particular article into a different thing. The Applicant respectfully disagrees.

The recited Claims transform an article containing word with ordinary spelling into an article containing a word with phonetic spelling. The Federal Circuit has held that an “article” is a physical object or substance, or a representation of a physical object or substance. *In re Ferguson*, 558 F.3d 1359, 1364 (Fed. Cir. 2009). In cases where the article is a representation of a physical object, the underlying physical object need not be undergo a physical transformation in order for the process claim to qualify as patentable subject matter. *In re Bilski* at 963. Here, independent Claim 15, upon which dependent Claims 16-20 depend, generally recites a word with ordinary spelling that is revised to include phonetic symbols that consist of underlined and non-underlined letters. Words necessarily must be written on a physical medium—especially when such a word is transformed by adding phonetic symbols that consist of underlined and non-underlined letters. Even if the Office reads the claim in its broadest terms, without importing any meaning from the specification, a person of ordinary skill in the art would understand that there is no way to practice this claim without writing down the words and the phonetic symbol on a physical medium—either on a physical object or on a physical computer screen.

III. Rejection Of Claims 15-20 Under 35 U.S.C. § 102(b)

The Office reiterated its rejection of Claims 15-20 under 35 U.S.C. §102(b) as being unpatentable over "Rocket Phonics." The Office argues (1) that the U.S. Copyright Office shows that the book "Rocket Phonics" was published on August 15, 2001, which is more than a year prior to this application's September 16, 2002 priority date; (2) that the submitted declarations fail to explain why the indicated date in the declaration contradicts the publication date indicated in the US Copyright Office; and (3) that the submitted evidence lists two possible publication dates: September 2, 2002 and August 8, 2002.

A. The Record At the U.S. Copyright Office Is Incorrect And Is Currently Being Fixed At The U.S. Copyright Office

As the Applicant has repeatedly iterated, an incorrect publication date was given to the United States Copyright Office in the application for registration for "Rocket Phonics." The Office now has a copy of the corrected Supplementary Registration that was filed with the United States Copyright Office on January 25, 2010 pursuant to 17 U.S.C. §408(d), and once the United States Copyright Office processes this registration, the Appellant will submit the new Supplementary Registration to this Board as evidence.

B. The Submitted Declarations Clearly State Why The Indicated Date In the Declaration Contradicts The Publication Date Indicated By The US Copyright Office

In paragraph 11 of the submitted declaration by Stephen Guffanti, and in the corrected supplementary registration that was filled out with the United States Copyright Office, Stephen Guffanti explains that when he originally filled out his copyright registration form, he mistakenly listed the date when he decided to create a book to publish, not when the book was actually published to the public.

C. The Submitted Declaration Date Of August 8, 2002 Is The Correct Publication Date

The Office is correct that the submitted evidence appears to list two different publication dates—September 2, 2002 and August 8, 2002. This is, again, as a result of the inventor's misunderstanding of the word "publication." However, the fact of the matter is that whether the Office accepts the August 8, 2002 date as being the date of publication, or the September 2, 2002 date as being the date of publication, neither date would be more than a year prior to this application's priority date. Any confusion between these two dates is immaterial to patentability.

The fact of the matter is that "Rocket Phonics" was never actually published until August 8, 2002, and that any submitted evidence of another date was due to the inventor's mistake in defining the term "publication." As such, "Rocket Phonics" can not qualify as prior art under 102(b), and this rejection should be withdrawn.

CONCLUSION

Claims 15-20 are patentable for being drawn towards a physical process of altering training material. While the book "Rocket Phonics" may teach some of the subject matter recited in the claims, the book is ineligible for 102(b) purposes since this application was filed within a year of the publication date of "Rocket Phonics."

Respectfully submitted,

Dated: December 28, 2010

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